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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|--------------------------------|------------------------|
| 10/686,751 | 10/16/2003 | Michael R. Furst | A2484K-US-NP XERZ 2 01274 | 8683 |
| 62095 7590 05/18/2010 FAY SHARPE / XEROX - ROCHESTER 1228 EUCLID AVENUE, 5TH FLOOR THE HALLE BUILDING CLEVELAND, OH 44115 | | | EXAMINER ESKANDARNIA, ARVIN | |
| | | | ART UNIT 2448 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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FAY SHARPE / XEROX - ROCHESTER
1228 EUCLID AVENUE, 5TH FLOOR
THE HALLE BUILDING
CLEVELAND OH 44115

MAY 18 2010

DIRECTOR OFFICE
TECHNOLOGY CENTER

In re Application of: Michael R. FURST et al.
Application No. 10/686,751
Filed: Oct 16, 2003
For: METHOD AND APPARATUS FOR
ENABLING DISTRIBUTED
SUBSCRIPTION SERVICES, SUPPLIES
MAINTENANCE, AND DEVICE-
INDEPENDENT SERVICE
IMPLEMENTATION

**DECISION ON PETITION
UNDER 37 C.F.R. § 1.181**

This is a decision on the petition, filed April 6, 2010, under 37 CFR § 1.181 to reconsider and reverse the examiner's premature Final rejection mailed Feb 17, 2010.

The petition is **DISMISSED**.

On April 6, 2010, applicant's counsel filed a petition to the Director under 37 CFR § 1.181 to seek relief from actions of the examiner Arvin Eskandarnia and SPE Firmin Backer in relation to the Final office action mailed Feb 17, 2010.

In the petition, applicant's counsel alleged that the examiner's Final Action "is not completely responsive" and the Advisory Action of March 23, 2010 "includes new grounds of rejection" not necessitated by amendment; thus, rendered the Final office action mailed Feb 17, 2010 premature.

MPEP § 706.07(a) states in part that:

Under present practice, second or any subsequent action on the merits *shall* be made final, except where the examiner introduces a new ground of rejection not necessitated by amendment of the application by the applicant, whether or not the prior art is already of record.

MPEP § 706.07(d) states in part that:

If, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection. Once the finality of the Office action has been withdrawn, the next Office action may be made final if the conditions set forth in MPEP § 706.07(a) are met.

MPEP § 1201 states, in part:


The line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the Director of the U.S. Patent and Trademark Office (Director) should be carefully observed. The Board will not ordinarily hear a question that should be decided by the Director on petition, and the Director will not ordinarily entertain a petition where the question presented is a matter appealable to the Board ...

A review of the prosecution history in the instant application and the petition indicates that there is a disagreement between the examiner and applicant's counsel on how to interpret various terms such as "interchange device model", "a device model agent", "physical add-on" and the manner in which the examiner interprets the claims and whether the reference(s) read on the claim limitations of claims 26-44. The Final Action of Feb 17, 2010 *repeats the rejections of claims 26-44 in the previous Non Final action (dated August 10, 2009)* and includes a response to arguments. The Final Action of Feb 17, 2010 is therefore proper since no new ground of rejections were introduced in the rejections of claims 26-44. The Advisory maintains the finality of the last Office Action and provides further explanation/response to arguments of the After Final request for reconsideration filed March 15, 2010. Thus, it is apparent that such a disagreement regarding claim interpretation and rejection is **appealable, not a petitionable matter**.

Pursuant to MPEP § 1201, the petition is **DISMISSED**.

Further, pursuant to 37 C.F.R. § 1.181(f), the shortened statutory period for reply is continued to run three months from the mailing date of the Final Office Action.

Any inquiry concerning this decision should be directed to Kim Huynh whose telephone number is (571) 242-4147.



Jack Harvey, Director
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